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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,085	02/15/2002	Michael Dennis Ryan	2010705	3496

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EXAMINER
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FIDEI, DAVID

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 02/26/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/077,085

Applicant(s)

Ryan et al.

Examiner

David T. Fidei

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-13, 16 and 17 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-9, 18-20, 22-24 and 26-28 is/are rejected.
- 7) ☒ Claim(s) 14, 15, 21, 25 and 29-34 is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 18 December 2003 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 5-9, 22, 24 and 26-28 are rejected under 35 U.S.C. 102(b, e) as being anticipated by Van Der Horst (Patent no. 6,474,539). The PCT Pub. Date of July 20, 2000 serves to establish the reference as prior art under 35 U.S.C. 102(b). The patent issue date of November 05, 2002 serves to establish the reference as prior art under 35 U.S.C. 102(e).

A container apparatus for simultaneously housing a product and premium is disclosed in col. 1, lines 1-13. As shown in figures 1-4, members 20 and 10 define a front panel and back panel. Two opposing side panels 12 have top and bottom edges. Panels 11, 21 along with the other un-numbered longitudinally extending end panels shown in figure form a top and bottom closure for enclosing a product, see col. 3, lines 9-11.

As shown in figures 1 and 4, at least one recessing flap (considered to define both a depth gauging panel and backing panel, page 14, third paragraph of applicant's response) is formed in the front panel 20. The recessing flap being further formed a depth-gauging panel 41 foldably emanating from the originating panel 20 along a selected edge 8 of the top 20 and a backing panel 45 foldably emanating an interior edge of the depth engaging panel 41 disposed opposite (at 9) from the selected edge 8 of the at least one recessing flap to form a recessed cell as shown in figure 4.

At least one access panel 21 (along with part 42) disposed in, and foldably emanating from one of the front panel, back panel, two opposing side panels top and bottom closure, disposed adjacent to said originating panel and foldably emanating from an opposite edge of the backing panel. The recessed cell spanning at least a portion of the originating panel 20 and at least a

portion of the at least one access panel to allow access to the recessed cell from outside the carton through at least two adjacent ones of said front panel, back panel, two opposing side panels, top closure and bottom closure. A “premium” item is placed in box 2 and is provided for receipt within the recessed cell, see figure 5.

As to claim 2, the recessed cell is separated at least partially from the interior region of the carton by the recessing flap.

As shown in figure 4, the “depth gauging panel” 41 is substantially orthogonal to the backing panel 40 as recited in claim 5.

With respect to claims 6-8, a container apparatus having the originating panel as the back panel, one of the side panels or the front panel directional relative designations. Which is no patentable significance since the container apparatus of figure 4 may be considered to have a front panel with the recess and the originating panel. Also, the container apparatus may be rotated ninety degrees so that the recess and originating panel may be said to be one of the side panels. Or, the container apparatus may be turned upside-down, from the orientation of figure 4 so that the originating panel is the back panel.

As to claim 9, part 42 is considered to be “at least one catch region” to facilitate retention of the premium item in the recessed cell, as shown in figures 4 and 6.

As to claim 22 a “premium cover” for retaining the premium inside the recessed cell is provided by box 2.

With respect to claim 24, the premium item 2 is no greater in thickness than the depth of the recessed cell, see figure 6.

As to claims 26, 27, the front panel 20, back panel 10 and two opposing side panels 12 have top and bottom edges including closure flaps shown in figure 1 to be panels 11, 21 along with the other un-numbered longitudinally extending end panels.

With respect to claim 28, col. 2, line 58 discloses a substantially paperboard material.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 18-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Der Horst as applied to claim 1 above, and further in view of Strehlow (Patent no. 6,173,833). The difference between the invention of claims 18-20 and the subject matter of Van Der Horst is that the premium item includes a tray for housing a promotional item, the tray includes a cover that is partially transparent and that the tray includes at least one flange abutting at least a portion of the originating panel and adjacent access panel. Van Der Horst discloses a box-like body that goes into recessed cell and abuts the adjacent access panel.

Strehlow discloses a premium package that teaches all of the above features for holding a promotional item 38, col. 4, line 34 in a tray 22, having a flange 34, 35 and a cover defined by either of 22 or 36 that is transparent, col. 3, line 12 and 30. Hence to provide a package combination that includes a tray as recited in claims 18-20 is fairly taught by the prior art. It would have been obvious to one of ordinary skill in the art to modify container apparatus of Van Der Horst by constructing a premium as Strehlow, in order to permit visibility of the product and enhance aesthetic appeal.

As to claims 22 and 23, modifying Van Der Horst as suggested by Strehlow results in the subject matter of these claims, i.e., a premium cover that is transparent to allow viewing.

***Allowable Subject Matter***

5. Claims 10-13 and 16-17 are allowed.

6. Claims 14, 15, 21, 25 and 29-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-9, 14, 15 and 22-28 have been considered but are moot in view of the new ground(s) of rejection. In contrast to Yoshiki et al '202 applicant further defines claim 1 to include a total of three movable flaps or panels. The depth gauging panel and the backing panel (which together form the at least one recessing flap) and the corresponding at least one access panel. These act together to form linkages or levers, to permit the backing panel to swing inwardly, page 14 of applicant's remarks.

However, this is not seen as defining anything novel over the prior art of record. Van Der Horst discloses this exact relationship in figures 1-4 and described in the above rejection. Accordingly, the claims fail to distinguish over Van Der Horst.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning the MERITS of this examination from the examiner should be directed to David T. Fidei whose telephone number is (703) 308-1220. The examiner can normally be reached on Monday, Thursday and Friday 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672.

Effective Monday morning, August 4, 2003, all official faxes for the TCs will be received in one central location in the Office. In cooperation with the Customer Service Goal Team, a new central official fax number (703-872-9306) has been established for use by the TCs. An OG notice will be issued and the Website updated to alert PTO customers of the new fax number. Official standalone (non-RightFax) fax machines will be removed from the TC fax centers, their phone numbers auto-forwarded to a single RightFax account, and faxes printed in the centralized fax center.


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Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8497
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>

  
David T. Fidei  
Primary Examiner  
Art Unit 3728

dtf  
February 25, 2004